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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,372	12/08/2000	Paul R. Petersen	M00-175100	1974

22835 7590 09/21/2004

PARK, VAUGHAN & FLEMING LLP
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EXAMINER

AKERS, GEOFFREY R

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,372

Applicant(s)PETERSEN, PAUL R. *SP***Examiner**

Geoffrey Akers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15,17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Request for Continued Examination(RCE)

1. This action is issued in reply to applicant's Request for Continued Examination(RCE) filed 7/7/04.
2. Claims 1,8,15 were amended. Claims 2,9,16 were cancelled.
3. Claims 1,3-8,10-15,17-21 as amended, are pending.

Claim Rejections - 35 USC § 103

4. Claims 1, 3-8, 10-15,17-21 as amended, are rejected under 35 USC 103(a) as unpatentable over Sipple(US Pat. No: 6,405,327) in view of alSafadi(US Pat. No: 6,467,088) in view of Smith(US Pat. No: 5,848,250) and further in view of Katz(US Pat. No: 6,055,513).

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5.As regard to claims 1,3-8,10-15,17-21: Applicant's invention of a system that facilitates a purchase of merchandise by a customer or user is taught in the following prior art. Applicant's invention teaches a method of determining upgrade requirements for a computer system(memory upgrade). However, the invention is taught by an upgrade of any device/software/hardware/system which is disclosed by art that shows determining system upgrades and making purchases online. The art that when combined teaches applicant's invention includes the following:

Sipple teaches performance monitoring of a user system to determine system upgrades that would system performance. System performance is monitored and compared to previous performance data to identify performance degradations or

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limitations that may be overcome by upgrades to the system. Sipple also identifies specific upgrades that could impact system performance problems(Abstract). Sipple further teaches an easy to understand informational message provided to a user as a computer operator for identifying subsystems that are performance inhibitors along with specific upgrade solutions that will address identified performance problems(col 6 lines 24-29). Sipple further teaches the automatic performance monitoring procedure that preferably obtains results from three of the computer subsystems: 1) the instruction processor, 2) the memory and 3) the I/O processor(col 10 lines 9-12). Sipple also teaches at block 1066 reception of control from block 1062 via interface 1065. Block 1066 notifies the computer operator of performance limiters detected in block 1062(col 10 lines 63-65)(col 11 lines 8-14)(col 11 lines 17-23).

In addition to that taught by Sipple, alSafadi further teaches a reconfiguration manager 10 interacting with an electronic device 12 (referred to as Device X). The device 12 may represent a desktop, laptop or palmtop computer, a personal digital assistant(PDA) a telephone, television, set-top box or any other type of consumer electronic processing device. The device 12 includes a number of software components 14A, 14B, 14C corresponding to version 1.1 of a software component A, version 2.3 of software component B, and version 2.0 of a software component C respectively. The reconfiguration manager 10 may be implemented on a computer or any other data processing system(col 3 lines 15-26). Additionally, alSafadi also teaches the reconfiguration manager 10 receiving a request 20 from a device 12. Here, the request 20 indicates that a user of the device 12 desires to upgrade the device to include

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version 2.0 of software component A. The request in the illustrative embodiment also includes a list of the components currently in the device, version 1.1 of component A, version 2.0 of component C and version 2.3 of component B. The request may include additional information such as any needed information regarding the interconnection of the components or other parameters associated with the device (col 4 lines 12-22). Also alSafadi teaches in step 100 the reconfiguration manager 10 obtaining information regarding the hardware and software configuration of device X, which is electronic device 12 of Fig 1. This information is included in request 20 sent by device 12 to the reconfiguration manager 10. In other embodiments, this information may be obtained from a local database based on a serial number or other identifier of the device (col 4 lines 39-47). Also alSafadi teaches that a particular set of upgrade configuration is selected in step 116 and the upgrade is approved in step 118 as compatible with the current configuration of device X. The selection in step 116 may be based at least in part on one or more established criteria as cost, maximum improvement in system operating speed, most recently modified, most energy efficient, etc. The reconfiguration manager then downloads the upgrade to device X in step 120 (col 5 lines 9-18). In addition, al Safadi teaches information regarding the particular components in the device may be determined by accessing a local database using the device identifying information and may be supplied directly by the user (col 6 lines 22-27). Also, al Safadi teaches implementing upgrading or any other reconfiguration of any desired type of software or hardware component, as well as combinations of these for any desired type of electronic device and the invention can be implemented in a software programs

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which are stored on an electronic, magnetic or optical storage medium and executed by a processing device (col 6 lines 28-41).

In addition to that taught by Sipple and alSafadi, Smith teaches a system for upgrading a personal computer that includes a motherboard having upgrade sockets for upgrading the CPU and the clock oscillator without the need to remove any components. The system includes sensing circuitry for detecting the type of component plugged into the upgrade socket and circuitry for disabling the upgraded component. Additionally, the system includes software for reconfiguring various depending upon the particular upgrade plugged unto the upgrade socket. By providing a system that can be upgraded by merely inserting a newer component, upgrades can be performed efficiently.

Additionally, the upgrade system allows the end user to utilize declining CPU

prices(Abstract). Smith also teaches that an important aspect of the invention is the ability of the system to provide multiple options with respect to the choice of CPU upgrades(col 3 lines 8-10).

In addition to that taught by Sipple, alSahadi and Smith, Katz further teaches goods, services and information being provided to the user via electronic communications as a telephone, videophone or other computer link as determined by the establishing communication via the electronic communications device between the user and the system to effect a primary transaction or primary interaction and then obtaining data with respect to the primary transaction or primary interaction including at least in part a determination of the identity of the user or prospective customer and then obtaining a second data element relating to the user, then utilizing a primary transaction or primary

interaction data along with the second data element as factors in determining one good service or item of information for prospective upsell to the user and offering the item to the prospective customer(Abstract). Furthermore, Katz teaches automatically initiating the purchase transaction involves automatically initiating the purchase transaction through a website that facilitates purchasing the memory upgrade option and the memory configuration information is automatically sent to the website so that the user does not have to reenter the memory configuration information in the teachings of consummation of either or both of the primary transaction or the derivative upsell transaction, an order fulfillment system may be utilized. Upon receipt of indication that the transaction is to be consummated the system may so designate the product and may automatically provide for shipping and billing to the user(col 11 lines 56-62).Katz further teaches in operation a user establishing communication with a telemarketer or through electronic contact as a website contact upon which identity information regarding the user is automatically obtained as through the use of ANI or manually, as through entry of identification information by the user. The identity information may be specific to the user or may be generalized such as information relating to the type of primary transaction. A second data element is obtained from a remote database which is then used in conjunction with the primary transaction data so as to select a subset of potential offers of goods services or information to the user. Upon selection the goods services or information are provided to the user and if the interaction is for the purpose of sale, the transaction is preferably consummated. Katz also teaches that inventory checks for the proposed offers as well as a credit authorization for the offer are made

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during the course of the communication and prior to the offer of the secondary item. Katz also teaches the intelligent selection and proffer of goods services and information respecting the user and utilizing the collected information in the selection of the goods, services or information to be provided to the user(col 11 line 63-col 12 line 26). Katz also teaches that a system user contacts the system for a primary transaction. If the user is a customer contacting a telemarketing system action block 10 a telemarketing operator may interact with the potential customer and take the order entry data for the primary transaction. Upon completion of the primary transaction as by a sale action(decision) block 12 is reached wherein order data is compared to one or more databases for analysis. The primary transaction may be a contact for a sale or other commercial transaction a service or repair transaction may be set for the purpose of the inquiry(col-13-lines-52-68).Katz also teaches basing the upsell selection on prior purchases which may include upgrades to prior purchases(col 24 lines 36-45). It would have been obvious to one skilled in the art at the time of the invention to combine Sipple in view of alSahadi in view of Smith and further in view of Katz to teach the disclosure. The motivation to combine is to teach a method of determining upgrade requirements for a computer system.

Response to Arguments

6. Applicant's arguments are not persuasive. Katz teaches automatically initiating the purchase transaction involves automatically initiating the purchase transaction through a website that facilitates purchasing the memory upgrade option and the memory configuration information is automatically sent to the website so that the user does not

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have to reenter the memory configuration information in the teachings of consummation of either or both of the primary transaction or the derivative upsell transaction, an order fulfillment system may be utilized. Upon receipt of indication that the transaction is to be consummated the system may so designate the product and may automatically provide for shipping and billing to the user(col 11 lines 56-62).

Conclusion

7. THIS ACTION IS MADE NON-FINAL.

Questions regarding this communication may be addressed to the primary examiner, Dr. Geoffrey Akers, P.E., who can be contacted at (703)-306-5844 between the hours of 6:30-AM and 5:00-PM Monday through Friday. If attempts to reach the primary examiner are unsuccessful, the examiner's supervisor, Mr. Vincent Millin, may be telephoned at (703)-308-1065.

September 19, 2004



**DR. GEOFFREY R. AKERS, P.E.
PRIMARY EXAMINER**